PETITION FOR TIME EXTENSION

This response is accompanied by a petition and fee to extend the period for response by two months. With allowance of the petition, the extended period for response ends June 25, 2005.

STATEMENT OF COMMON OWNERSHIP

At the time the invention of Application No. 10/032,900 was made, Vesta Corporation owned Application No. 10/032,900 and U.S. Patent Application Serial No. 09/479,768. U.S. Patent Application Serial No. 09/479,768 was published as Patent Application Publication 2003/0174823, cited in the Office action dated January 25, 2005, and issued as Patent No. 6,516,056. This response is also accompanied by a copy of an assignment of rights of the inventions disclosed in the present application to Vesta Corporation of Portland, Oregon. This assignment is signed by one of the inventors, and will be signed by the other inventor when he is available. The assignment of the inventions disclosed in U.S. Patent Application Serial No. 09/479,768 of Scott C. Justice, Eric L. Hopper, and Ken C. Obrist for a FRAUD PREVENTION SYSTEM AND METHOD, was recorded in the United States Patent and Trademark Office on January 7, 2000 under Reel 011013, Frame 0931.

REMARKS

The above amendments and these remarks are responsive to the Office action dated January 25, 2005. With entry of the above amendments, claims 1-55 are pending in the application. Original independent claims 1, 24, 47, 53 and 54 are currently amended. Dependent claims 42, 46 and 49-51 are currently amended to

correct typographical errors and provide consistency with the claims from which they depend. New claim 55 is generally a combination of original claims 24 and 40.

In the Office action, the Examiner rejected:

(a) original claims 1-15, 17, 20 and 54 as being anticipated by Suryanarayana et al., U.S. Patent No. 6,487,401;

(b) original claims 1-7, 10, 11, 13-15, 19, 21, 22, 24 and 53 as being anticipated by Dahm et al. U.S. Patent No. 6,466,783;

(c) original claims 16 and 18 as being unpatentable over Dahm or Suryanarayana;

(d) original claim 23 as being unpatentable over Dahm or Suryanarayana in view of Justice et al. (U.S. Patent Application Publication No. 2003/1074823);

(e) original claims 25-28, 30-45 and 48-51 as being unpatentable over Dahm in view of Suryanarayana;

(f) original claim 29 as being unpatentable over Dahm in view of Suryanarayana; and

(g) original claims 40, 46 and 52 as being unpatentable over Dahm in view of Suryanarayana, and further in view of Justice.

In view of the amendments above, and the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111, withdrawal of the rejections, and allowance of the pending claims.

Rejections under 35 USC § 102

A. Claims 1-15, 17, 20 and 54 were rejected as being anticipated by Suryanarayana. In order for there to be anticipation under 35 U.S.C. § 102, every element of a claimed invention must be disclosed in a single reference. As discussed in further detail below, rejection of claims 1-15, 17 and 20 is improper at least because Suryanarayana does not disclose a telephone device having a recharge option configured to cause the communications program to initiate both a connection to a communication network and a recharge transaction with the recharge service via the communication network. Rejection of claim 54 is improper because Suryanarayana does not disclose storing in a wireless telephone device while the device is not in communication with a recharge service, a calling balance of a stored value calling account; detecting that the stored calling balance is lower than a predetermined threshold; and presenting a recharge option on a display of the device, the recharge option, when selected by a user, being configured to initiate both connection to a communication network and a recharge transaction, in order to add calling units to the stored value calling account.

Claim 1 is directed to a wireless telephone device having an associated stored-value calling account, the wireless telephone device comprising a selector; a communications program configured to communicate with a recharge service via a communication network; and a recharge option selectable by a user upon actuation of the selector, the recharge option being configured to cause the communications program to initiate both a connection to the communication network and a recharge transaction with

the recharge service via the communication network, in order to add calling units to the stored-value calling account. This may be provided, for example, by a software program resident on the mobile device that originates the complete recharge transaction.

Fig. 1 of the present application schematically illustrates a nonlimiting example of such an arrangement.

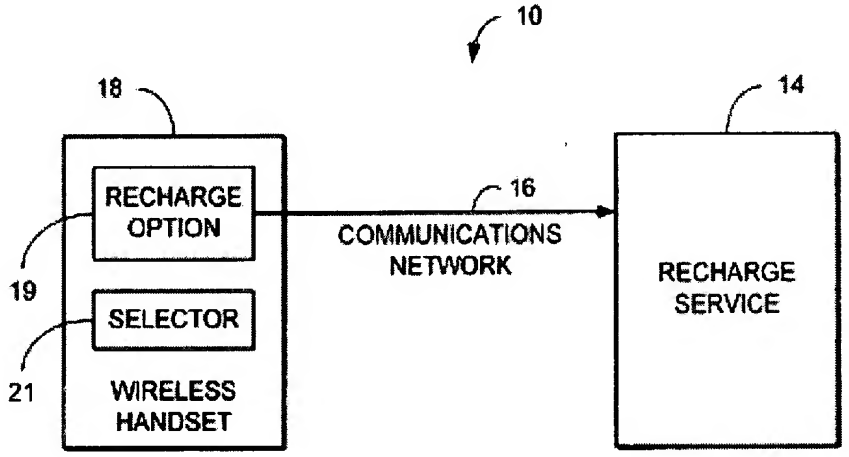


FIG. 1

Recharge system 10 typically includes a wireless telephone device 18 having a recharge option 19 that may be activated by a selector 21, in order to initiate a recharge transaction with recharge service 14, and add calling units to a stored-value calling account associated with wireless telephone device 18. Wireless telephone device 18 is typically configured to communicate with recharge service 14 via communication network 16.

Fig. 4 illustrates a further non-limiting example of a wireless telephone device 18 in the form of a web-enabled wireless handset having a processor 18a, a wireless

transceiver 18b configured to communicate with wireless network 16, and memory 18c. Memory 18c typically includes communications program(s) 18n. Communications program(s) 18n typically include a telephone communications program 18o configured to manage telephone calls placed and received through the wireless network 30, and a web browser 18p configured to download web pages from remote websites via a WAP gateway, and present the web pages on display 18g.

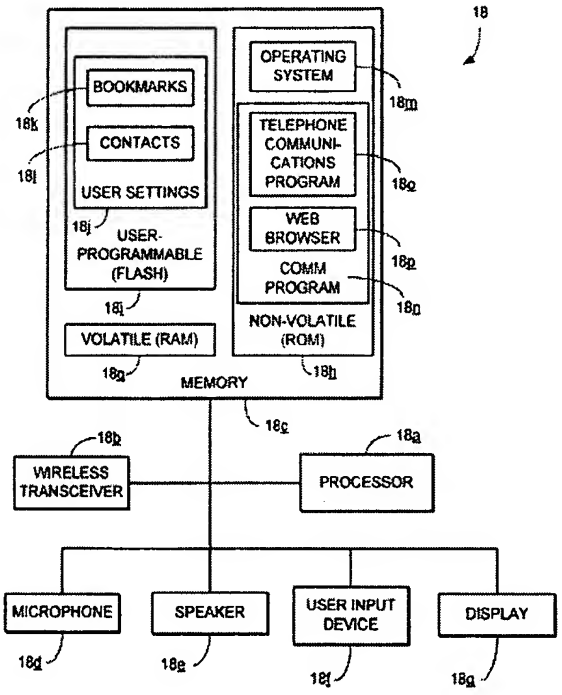


FIG. 4

Typically, wireless telephone 18 is associated with a stored-value calling account, the balance of which may be stored on the handset itself, or in a database associated with the telephone carrier. To recharge the stored-value calling account, the user may choose recharge option 19 by actuating selector 21 on the wireless telephone 18. In

response to selection of the recharge option, the recharge option is configured to cause communication program 18n to initiate a recharge transaction with the recharge service 14 via the communication network 16, in order to add calling units to the stored-value calling account. For web-based calling account recharge, the recharge option may be configured to cause the web browser 18p to contact a recharge server 36 of the recharge service via the WAN, and download a recharge web site for display on wireless telephone device 18. For telephone-based calling account recharge, the recharge option may be typically configured to cause the telephone communications program 18o to contact recharge service 14 via a telephone call placed over the telephone network.

On the contrary, Suryanarayana discloses a prepaid wireless telephone account regeneration system in which the associated wireless telephone may be any commercially available device. "The present invention operates with any wireless device capable of running a mobile client process to interact with the WAP system." Column 2, lines 66 and 67. In all cases, communications regarding the status and recharge of a prepaid account are initiated by the recharge server, and never by the wireless device." This is illustrated in Figs. 2-5 and 8. Fig. 5 is reproduced below.

"Fig. 3 illustrates a call flow diagram of the prepaid account recharge process of the present invention. The process starts by the service control point (SCP) performing a push operation (301) to inform the cellular telephone user that a recharge of the prepaid account may be required." Column 4, lines 4-8. "In an alternative embodiment, the recharge application is available at a URL on the WTA server. In this

case, the Push service Indication sent to the client includes only the URL. The client then retrieves (pulls via WSP/HTTP GET) the content associated with the recharge notification." Column 4, lines 33-37.

Referring to Fig. 4, "the SCP tracks the user's account level while the call is in process. When the account reaches a predetermined level, the SCP sends out a warning signal to the user's mobile client." Column 5, lines 8-11.

"Fig. 5 illustrates the prepaid account recharge process of the present invention. The process starts by the SCP sending a message to the mobile client software via the WAP network (step 501)." Column 5, lines 45-48.

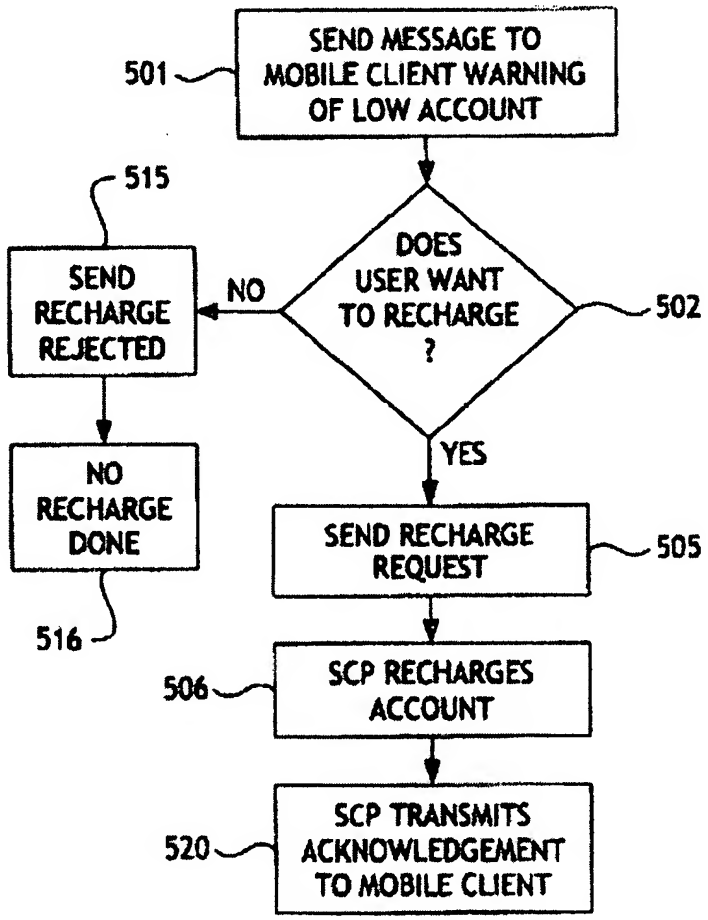


Fig. 5

Fig. 8 illustrates a process in which the SCP authorizes a call placed by the mobile client, and notifies the mobile client of the anticipated cost of the call. The mobile client then has the opportunity to continue or terminate the call. "If the user compares the anticipated call charges and the account balance and determines that an account recharge is required to continue the call, the above recharge processes of the present invention are used."

Therefore, it is clear that in the system disclosed by Suryanarayana all recharge notices, account information and recharge communications are initiated by the service control point. Because the mobile devices disclosed by Suryanarayana do not have a recharge option configured to cause the communications program to initiate both a connection to a communication network and a recharge transaction with the recharge service via the communication network, Suryanarayana cannot anticipate independent claim 1. Accordingly, independent claim 1 is allowable over Suryanarayana, and rejection of claim 1 should be withdrawn. Furthermore, because claims 2-15, 17 and 20 depend from claim 1, those claims are allowable for at least the same reasons as claim 1. Accordingly, rejection of claims 2-15, 17 and 20 also should be withdrawn for at least this reason.

Independent claim 54, as amended, recites "a method for use in a wireless telephone device having a display, the method comprising:

storing in the device while the device is not in communication with a recharge service, a calling balance of a stored value calling account;

detecting that the stored calling balance ~~of a stored value calling account~~ is lower

than a predetermined threshold; and

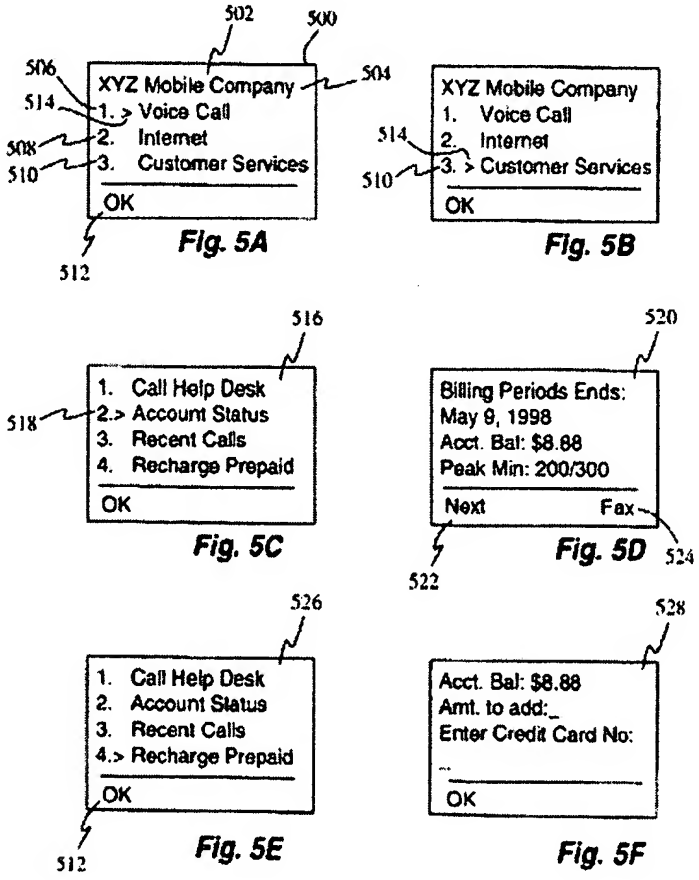
presenting a recharge option on a display of the device, the recharge option, when selected by a user, being configured to initiate both communication with a recharge service and a recharge transaction, in order to add calling units to the stored value calling account."

As discussed above, Suryanarayana discloses a recharge method in which conventional wireless telephone devices are used, and all account and recharge communication is initiated by the recharge server, referred to as a service control point (SCP). There is no resident account balance information stored in the wireless device. Accordingly, Suryanarayana cannot anticipate claim 54, making claim 54 allowable over Suryanarayana, and rejection of claim 54 should be withdrawn.

B. Claims 1-7, 10, 11, 13-15, 19, 21, 22, 24 and 53 were rejected as being anticipated by Dahm. As discussed above, claim 1 is directed to a wireless telephone device having an associated stored-value calling account, the wireless telephone device comprising a selector; a communications program configured to communicate with a recharge service via a communication network; and a recharge option selectable by a user upon actuation of the selector, the recharge option being configured to cause the communications program to initiate both a connection to the communication network and a recharge transaction with the recharge service via the communication network, in order to add calling units to the stored-value calling account.

Dahm discloses "a method and apparatus for providing visual interfaces to mobile subscriber account services suitable for mobile devices with a small screen and phone

keypad communicating, via a wireless data network. As described in the background section of Dahm, the invention is intended to provide a visual interface for users of mobile devices that avoids users having to call a human-staffed call centers or interactive voice response (IVR) systems "to allow the subscribers to call in and inquire about their accounts or place service requests" (Column 1, lines 32-34). As with Suryanarayana discussed above, Dahm discloses a system in which the "server device (also referred to as proxy server herein), generally controlled by a wireless service carrier, provides the mobile subscriber with account services such as user account information and user controllable service requests . . ." The process for recharging a prepaid account is illustrated in Figs. 5A-5F, shown below, and described in the associated description.



The following discussion includes excerpts from the description of these figures, beginning with line 60 of column 8. "When the client device is turned on, an initial screen display 502 is displayed on screen 500." "FIG. 5B shows that element indicator 514 has been moved down to 'Customer Services' 510. Generally, the client device makes a connection request to a server device that in turn returns the requested information depending on the exact setup of the accessed account. The returned information, typically cached first, is then displayed in screen display 516 as shown in FIG. 5C." "FIG. 5E displays screen display 526 provided the user chooses the fourth choice 'Recharge Prepaid' in screen display 516 of FIG. 5C."

It is thus clear that the mobile device of Dahm is configured to contact the mobile subscriber account server device, analogous to a subscriber calling a customer service representative at a customer service center. Once contact with the server device is established, then information and account services are downloaded from the server device and displayed on the mobile device. Thus, it is clear that menu 516 includes a fourth option of selecting a "recharge prepaid" that is downloaded from the server device, and the mobile device is not configured with that option. Further, the communication between the mobile device and the server device must have been established in advance of receiving the recharge prepaid option, or else the mobile device would not have been able to display the recharge prepaid option. When the user selects the recharge prepaid option, the communication link is not initiated, as it already exists. Additionally, the mobile device is not configured to have the prepaid recharge option. The option exists only when the option is part of a display received

from the server device.

Because the mobile devices disclosed by Dahm do not have a recharge option configured to cause the communications program to initiate both a connection to a communication network and a recharge transaction with the recharge service via the communication network, Dahm cannot anticipate independent claim 1. Accordingly, independent claim 1 is allowable over Dahm, and rejection of claim 1 should be withdrawn. Furthermore, because claims 2-7, 10, 11, 13-15, 19, 21 and 22 depend from claim 1, those claims are allowable for at least the same reasons as claim 1. Accordingly, rejection of claims 2-7, 10, 11, 13-15, 19, 21 and 22 also should be withdrawn for at least this reason.

Claim 24 is directed to a method of recharging a stored-value calling account, comprising installing a recharge option in a wireless telephone device, the recharge option being configured to initiate a recharge transaction, in order to add calling units to a stored-value calling account associated with the wireless telephone device; displaying the recharge option on the wireless telephone device; receiving a user selection of the recharge option; and in response to the received user selection of the recharge option, both establishing a connection to a communication network and initiating the recharge transaction.

As discussed above, Dahm discloses a system that provides connection with an account server before a recharge option is downloaded and displayed on a mobile device. At the time the recharge option is selected, connection to the communication network and communication with the account server already exists. Accordingly, Dahm does not

disclose, in response to the received user selection of the recharge option, both establishing a connection to a communication network, and initiating the recharge transaction. Hence, claim 24 is allowable over Dahm, and rejection of claim 24 should be withdrawn.

Claim 47 is directed to a pre-paid wireless telephone recharge system, comprising a recharge server connected to a communication network, the recharge server being configured to perform a recharge transaction on a stored-value telephone calling account; and a web-enabled wireless telephone device having a recharge option installed thereon, the recharge option being selectable by a user upon actuation of a user input device on the wireless telephone device, the recharge option further being configured to cause a communication program on the wireless telephone device to initiate both a connection to the communication network and a recharge transaction with the recharge server via the communication network, in order to add calling units to the stored-value calling account.

As discussed above, Dahm does not disclose a wireless telephone device having a recharge option, that when selected initiates both a connection to the communication network and a recharge transaction with the recharge server via the communication network. Accordingly, claim 47 is allowable over Dahm, and rejection of claim 47 should be withdrawn.

Claim 53 is directed to a wireless telephone device, including a user interface having a top menu; a recharge option installed in the top menu, the recharge option being, upon selection, configured to initiate both connection to a communication network and a recharge transaction, in order to add calling units to a stored value calling account

associated with the wireless telephone device. As shown in Fig. 5A, the top menu of the mobile device of Dahm does not include a top menu with a recharge option. As defined at page 14, lines 15-18 of the applicants' specification, a top menu is "the highest-level menu in the menu hierarchy of the user interface of wireless telephone 18, and is the menu displayed to the user while the device is at rest."

Further, the mobile device of Dahm does not include a resident recharge option, or a recharge option configured to initiate both a connection to a communication network and a recharge transaction. Hence, claim 53 is allowable over Dahm, and rejection of claim 53 should be withdrawn.

Rejections under 35 USC § 103

C. Claims 16 and 18 were rejected as being unpatentable over Dahm or Suryanarayana. Because claims 16 and 18 depend from claim 1, those claims are allowable for at least the same reasons as claim 1 is allowable, as discussed above with regard to both Dahm and Suryanarayana. Accordingly, rejection of claims 16 and 18 also should be withdrawn for at least this reason.

D. Claim 23 was rejected as being unpatentable over Dahm or Suryanarayana in view of Justice. Because claim 23 depends from claim 1, that claim is allowable for at least the same reasons as claim 1 is allowable, as discussed above with regard to both Dahm and Suryanarayana. Accordingly, rejection of claims 16 and 18 also should be withdrawn for at least this reason.

Additionally, Justice is not valid prior art and may not be relied on under 35

U.S.C. § 103(c) because when the invention of Application No. 10/032,900 (the present application) was made, Vesta Corporation owned both Application No. 10/032,900 and U.S. Patent Application Serial No. 09/479,768. This fact is stated above in the statement of common ownership section preceding the remarks section of this response. U.S. Patent Application Serial No. 09/479,768 was published as Patent Application Publication 2003/0174823, cited by the Examiner. Accordingly, the rejection of claim 23 should also be withdrawn for at least this reason.

E. Claims 25-28, 30-45 and 48-51 were rejected as being unpatentable over Dahm in view of Suryanarayana. Because claims 25-28 and 30-45 depend from independent claim 24, those claims are allowable for at least the same reasons as claim 24 is allowable, as discussed above with regard to Dahm. Similarly, because claims 48-51 depend from independent claim 47, those claims are allowable for at least the same reasons as claim 47 is allowable, as discussed above with regard to Dahm. Accordingly, rejection of claims 25-28 and 30-45 also should be withdrawn for at least this reason.

F. Claim 29 was rejected as being unpatentable over Dahm in view of Suryanarayana. Because claim 29 depends from claim 1, that claim is allowable for at least the same reasons as claim 1 is allowable, as discussed above with regard to both Dahm and Suryanarayana. Accordingly, rejection of claim 29 also should be withdrawn for at least this reason.

G. Claims 40, 46 and 52 were rejected as being unpatentable over Dahm in view of Suryanarayana, and further in view of Justice. Because claims

40 and 46 depend from independent claim 24, those claims are allowable for at least the same reasons as claim 24 is allowable, as discussed above with regard to Dahm. Similarly, because claim 52 depends from independent claim 47, that claim is allowable for at least the same reasons as claim 47 is allowable, as discussed above with regard to Dahm. Accordingly, rejection of claims 40, 46 and 52 also should be withdrawn for at least this reason.

Additionally, Justice is not valid prior art and may not be relied on under 35 U.S.C. § 103(c) because when the invention of Application No. 10/032,900 (the present application) was made, Vesta Corporation owned both Application No. 10/032,900 and U.S. Patent Application Serial No. 09/479,768. This fact is stated above in the statement of common ownership section preceding the remarks section of this response. U.S. Patent Application Serial No. 09/479,768 was published as Patent Application Publication 2003/0174823, cited by the Examiner. Accordingly, the rejection of claim 23 should also be withdrawn for at least this reason.

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Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 24, 2005.

Tamara Daw

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